FILED
APR 6 1951
CHARLES ELMORE CROPLEY

IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 446

CREST SPECIALTY (NOT INC.), A LIMITED PARTNERSHIP CONSISTING OF BEN B. MANASTER, ROSE MANASTER, CAROL RUTH MANASTER, AND SOL ELIOT,

Petitioner,

vs.

DAVID C. TRAGER, DOING BUSINESS AS TOPIC TOYS, AND EOINA NUDELMAN, AN INDIVIDUAL,

Respondents.

PETITIONER'S REPLY BRIEF.

CLARENCE E. THREEDY,
111 West Washington Street,
Chicago 2, Illinois,
Attorney for Petitioner.

THE BUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

INDEX.

PAGE

I. It is inescapable that the sole difference between the Nudelman device and the prior art patent to Smith is in the shape of the Nudelman device 1

II. The Smith device is capable of the identical purpose and function of the Nudelman device.... 3

III. Neither of the claims in issue describes that the contents of the spoon which is emptied into the passage is taken from the bowl with which the device is associated..... 5

IV. The trial court made no finding of fact that the claims in issue were limited in the manner argued by respondents (p. 18)..... 6

V. The fact that the purpose and function of a device is new and useful, is not alone sufficient to meet the "flash of genius" test formulated by this Court in Cuno Engineering Corporation v. Automatic Devices Corporation, 314 U. S. 84 at 91, nor the standard of invention as required by the Constitution..... 7

VI. The facts of this case come squarely within the decision of this Court in The Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation, 340 U. S. 147..... 8

VII. Contrary to respondents' argument, the Court of Appeals for the Seventh Circuit did reject and refuse to follow the "flash of genius" test formulated by this Court in Cuno Engineering Corporation v. Automatic Devices Corporation, 314 U. S. 84 at 91..... 9

VIII. The patented device in and by itself has no commercial value.....

IX. The standard of patentability is a Constitutional standard and the question of validity of a patent is a question of law.....

Conclusion .....

CASES CITED.

Atlantic Works v. Brady, 107 U. S. 192 at 200.....

Barie v. Superior Tanning Co., 182 F. 2d 724 (C. A. 7)

Chicago Steel Foundry Co. v. Burnside Steel Foundry Co., 132 F. 2d 812 (C. A. 7).....

Cuno Engineering Corporation v. Automatic Devices Corporation, 314 U. S. 84 at 91.....7,

Falkenberg v. Bernard Edwards Co., 175 F. 2d 427 (C. A. 7).....

Great Atlantic & Pacific Tea Company, The v. Supermarket Equipment Corporation, 340 U. S. 147.....8, 9, 10, 11, 12,

Roberts v. Ryan, 91 U. S. 150 at 157.....

White v. Dunbar, 119 U. S. 47 at 51.....

IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 446

CREST SPECIALTY (NOT INC.), A LIMITED PARTNERSHIP CONSISTING OF BEN B. MANASTER, ROSE MANASTER, CAROL RUTH MANASTER, AND SOL ELIOT,

Petitioner,

vs.

DAVID C. TRAGER, DOING BUSINESS AS TOPIC TOYS, AND EOINA NUDELMAN, AN INDIVIDUAL,

Respondents.

PETITIONER'S REPLY BRIEF.

To the Honorable the Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

This is petitioner's brief in reply to respondents' brief filed in this case.

I.

Respondents' argument as contained in their brief may be boiled down to this:

While the trial court in this case found and the Court of Appeals affirmed that the Smith prior art device (R. 170) was diametrically opposed in purpose and function to the Nudelman device the trial court was moved to make

such finding as was the Court of Appeals, because of the specific shape of the Nudelman device and not because of any difference in the elements of the combination of claims 2 and 3 and those of the Smith device.

Confirmation for this conclusion is found in the fact that the trial court made no finding that the elements of the combination defined by claims 2 and 3 were not old in the art. Furthermore the respondents frankly admit (P. 30, l. 13) that:

> *"It is essential to the purpose of the Nudelman structure that the device take the form of a living creature in order that the illusion of eating be created. Unless the structure takes on such a recognizable form, the whole objective fails and no useful purpose will be served."* See also p. 6, last line, resp. brief.

From such confession resolves the question: Did Nudelman in forming his device to simulate a living creature meet the statutory requirements for invention by promoting the arts and sciences and adding to the sum of useful knowledge?

This question must be answered in the negative because it was old in the art to form or shape a body to simulate a living creature (see Bowen, R. 136; Shea, R. 140; Livingston, R. 148; Trosper, R. 152; Theodoropulos, R. 158*).

Even if it were not old in the art to do so, to form a body to simulate a living creature constitutes merely a matter of

---

NOTE: Emphasis briefwriter's unless otherwise indicated.

Respondents in making reference to the Manaster patent, the validity of which is not here in issue, would have done well to have written that Manaster, upon finding the Smith patent (R. 170) as a result of the stated search of the art, unlike Nudelman, made no claim to the Smith structure as his invention but confined his claims to a single feature of the oscillatory head of the dog to simulate eating upon engagement with the spoon when the latter is withdrawn from the mouth of the dog.

* Each of these patents shows it to be old to hinge the head of the figure to the body.

design and choice. Nudelman in forming the otherwise old Smith device to simulate a living creature, did nothing more than would be done by an artisan skilled in the art. If there were any invention in the shape of the Nudelman device, he should have taken out a design patent. He did not do so because, as frankly admitted by respondents (R. 66), if such a design patent had been taken out by respondents, such patent would have been invalid. In this connection, when before the trial court, respondents argued (R. 66):

> "Of course, if we had taken out a design patent on the *shape of the pig*, such a patent *would be invalid*, but where we have the shape of a pig or the *shape of an animal as being of the essence of this invention*, it is very essential, in order to carry out Nudelman's concept, that you have a figure simulating a living creature, a living animal, so that you may put food into its jaws, which has the psychology of mimicry, which this device has and which makes this device a very useful device, and that is why I objected to Mr. Snow striking from Claim 2 the simulation of an animal, simulating the figure of an animal because that is very essential to this invention and that is something which you find in the puppy device."

II.

In the second footnote appearing on page 14 of respondents' brief, it is stated by respondents that the Smith device is inoperative for at least one type of dry cereal, to-wit, corn flakes.

While corn flakes, either in a dry or wet state, is not generally classified as a baby food, whether corn flakes will be funnelled through the Smith hopper depends upon the form and the size of the passage. As confirmation of this, is the fact that the petitioner's accused device (Plf. Exh. 2) held to infringe claims 2 and 3, cannot, as demonstrated by

petitioner's witness Snow (R. 63)* function to funnel corn flakes back into the bowl after being emptied into the passage of such accused device.

Furthermore, the claims in issue do not specify the type of food which is to be emptied into the passage from the spoon. Such claims merely state that that which is to be emptied into the passage from the spoon is the "contents" of the spoon. All that is required of the patented device (and the same is true with respect to the prior art Smith device), is that the contents be of such character as will gravitate through the passage into the bowl, and such contents, as broadly stated in each of the claims in issue,** might be any of the well-known baby foods, such as Pablum, Farina, strained baby foods, milk, and the like.

If respondents meant to attack the operativeness of the Smith device, their claim of inoperativeness is untenable and without merit.

---

*"Q. I am handing you the defendant's device marked for identification as Plaintiffs' Exh. No. 2, and also corn flakes and some milk—and I have a blotter here which you might use, and do it very quickly and rapidly so as not to take up any unnecessary time.

A. For the purpose of the record I have placed some corn flakes, the same corn flakes that were used in connection with the demonstration this morning into the bowl of defendants' construction.

I have taken some corn flakes in a spoon with milk and placed it into the mouth of the defendant's puplike structure and I want to call the Court's attention to the fact that no corn flakes will pass through this passageway (indicating).

The fluid will, the fluid will fall right through but the corn flakes will not.

It is almost impossible, your Honor, to get the corn flakes on the line that passes through that passageway. They all jam right into the passageway and none pass through.

If you will close the head a minute and turn it over, your Honor, you can look into the interior of that passageway and see they will not pass through."

**Neither claim limits the use of the claimed device to any particular kind of food. Each claim describes that which is emptied from the spoon into the passage as "contents."

III.

Neither of the Claims in Issue Describes That the Contents of the Spoon Which Is Emptied Into the Passage Is Taken from the Bowl With Which the Device Is Associated. As to This There Is No Dispute.

The trial court in this case in finding that the Smith device was diametrically opposed in purpose and function to the Nudelman device, did not find and conclude, as respondents would make it appear, that the Smith device could not be used to interest a child to eat by taking a spoonful of the contents of the bowl and emptying it into the passage of the hopper for funnelling back into the bowl. While Smith in his specification does not so describe the use of his device, such use is obviously inherent to the structure thereof. This Court has consistently held in cases where a new purpose is claimed for an old machine or device, that:

> "It is no new invention to use an old machine for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he conceived the idea of the use or not." *Roberts* v. *Ryan*, 91 U. S. 150 at 157.

If a mother so desired in the feeding of a child, she could use the Smith device (Def. Exh. 3-3a) in the identical manner of the Nudelman device, *i. e.*, place the contents into the Smith bowl 6′ instead of into the hopper, and then take a spoonful of said contents from such bowl and empty it into the passage 10′ for funnelling back into the bowl 6′. Respondents do not argue to the contrary. Furthermore, the trial court made no finding of fact that food could not be placed in the bowl of the Smith device and taken therefrom by a spoon and emptied into the passage for return to the bowl.

It is erroneous and misleading for respondents to argue that the Nudelman device as claimed accomplishes the result of teaching a child to eat by the process of mimicry, for the reason that in order to carry out such teaching it is necessary that there be present, in addition to the claimed device, the unpatented bowl and the presence of the mother.

IV.

The Trial Court in This Case Made No Finding of Fact That the Claims in Issue Limit or Locate the Exit of the Passage* With Respect to the Bowl or Limit the Body Portion, Which is Placed Adjacent the Exterior of the Bowl, to a Main, Central and Principal Portion of the Figure; Nor Did the Trial Court Below Make Any Finding That the Claims in Issue Define the Passage of the Claimed Device to be Short and to Terminate Adjacent the Top Rim of the Bowl and be Located at Right Angles to the Base of the Bowl, as Respondents Would Make It Appear in Their Endeavor to Distinguish the Claims From the Smith Device (p. 18).**

No such finding could have been made by the trial court in this case because the claims are not so limited.

Any such attempt on the part of respondents to go beyond the claims in issue and draw upon the specification and drawings of the patent in suit to accord them novelty over the prior art, particularly the Smith device, is clearly contrary to well established principles of patent law. In this connection, this Court has consistently held that:

"Some persons seem to suppose that a claim in a

* With respect to the passage, the claims read (R. 133): "said forwardly extending portion having a simulated mouth and a passage, said passage having walls extending solely downward from said mouth through said forwardly extending portion."

** With respect to the body portion, the claims read (R. 133): "a body portion adapted to be placed adjacent the exterior of a feeding bowl."

> patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from what its words express. The context may, undoubtedly, be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claims; *but not for the purpose of changing it, and making it different from what it is.*" *White* v. *Dunbar*, 119 U. S. 47 at 51.

The trial court in this case did not find and conclude that the claims in issue define a combination of new elements or a combination of old and new elements. There is no finding by the trial court that the prior art patents do not disclose the elements of the claimed combination. When the trial court in this case found that the Smith device was unlike the Nudelman device in structure, it clearly had in mind the shape of such Nudelman device. As confirmation of this statement is the indisputable fact that when the claims in issue are read upon the prior art, particularly the Smith patent, the device defined by each claim differs from the Smith patent only in shape.

V.

The Fact, if Such It be, That, as Claimed by Respondents, the Purpose and Function of a Device is New and Useful, Does Not Meet the "Flash of Genius" Test Formulated by This Court in Cuno Engineering Corporation v. Automatic Devices Corporation, 314 U. S. 84, at 91, Nor the Standard of Invention as Required by the Constitution.

In the *Cuno* case, this Court formulated the rule that to be patentable, the purpose and function of a device must not only be new and useful but the device must also meet the Constitutional requirement *of promoting the arts and sciences and adding to the sum of useful knowledge.*

As the object of the Nudelman device, to-wit, that of

interesting and stimulating a child to eat, is no different from that of the Smith device* and as both devices provide passages capable of the identical function of funnelling food into a bowl, Nudelman did nothing to promote the art and sciences, nor did he add to the sum of useful knowledge by forming his device to simulate a living creature.

VI.

A reading of Respondents' Brief Shows That the Facts of This Case Come Squarely Within the Decision of This Court in The Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation, 340 U. S. 147.

In that case this Court laid down the rule that a patent for a combination which only unites old elements with no change in their respective functions, does not meet the Constitutional requirement for invention.

In the case at bar, the claims in issue are combination claims—a fact not denied by respondents. All the elements set forth in each claim are old in the art. The shape of the Nudelman device in no way alters or modifies the functions of such elements. For example, the old function of the passage in delivering food to the unpatented bowl, as well as the old function of the old means (24 of Smith, Fig. 4, R. 170) for preventing lateral displacement of the passage from over the bowl, would in no way be changed by reason of the shape of the device. These elements perform their respective functions irrespective of the shape of the device. Respondents do not contend to the contrary.

---

* In Smith's specification (R. 171, col. 1, ll. 39-48), he states: "It is also a purpose of my invention to provide a cereal dish of the above character, which due to the movement of the cereal into the liquid receiving portion, will interest a child eating cereal, in the operation of eating the same, to an extent that would not otherwise exist in children who do not particularly care to eat cereals of this character, thus aiding in feeding such children cereal by arousing their interest in the process of eating the same."

As in *The Great Atlantic & Pacific Tea Company* case, neither Court below in this case "has made any finding that the old elements which made up this [Nudelman] device perform any additional or different function in the combination than they performed out of it."

Contrary to respondents' argument, the decision of this Court in *The Great Atlantic & Pacific Tea Company* case is therefore especially applicable to the facts of this case. Under the doctrine there announced the patent in suit is invalid.

VII.

Petitioner Stated in Its Brief That to Petitioner's Knowledge the Court of Appeals for the Seventh Circuit in Several of Its Recent Decisions Rejected the "Flash of Genius" Test of Invention as announced in Cuno Engineering Corporation v. Automatic Devices Corporation, 314 U. S. 84, at 91. Respondents have not shown to the contrary.

Respondents offer the untenable argument that, contrary to petitioner's contention, the Court of Appeals for the Seventh Circuit, when it said that it "rejected the flash of genius test" formulated by this Court in the *Cuno* case, meant that the *Cuno* case did not formulate a higher standard of invention than existed previous to the decision in the *Cuno* case.

A review of the following cases decided by the Court of Appeals for the Seventh Circuit will show that respondents' argument in the above respect is without merit.

In *Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, 132 F. 2d 812, the Court of Appeals (7th) said (p. 817):

> "The test of a 'flash of genius' *should be rejected* not only because it is incapable of acceptable definition but because it injects into the Statute something not appearing therein."

Falkenberg v. *Bernard Edwards Co.*, 175 F. 2d 427 (decided June 21, 1949), was an appeal from the trial court's finding that while the patented device was novel, presented genuine improvement, and had remarkable public acceptance, there was absent the flash of genius as described in the *Cuno* case. The Court of Appeals for the Seventh Circuit in holding that the trial court erred in applying the "flash of genius" test, said (p. 428):

> "As we have done heretofore (*Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co., supra*), *we reject the flash of genius test.*"

In *Barie* v. *Superior Tanning Co.*, 182 F. 2d 724 (decided June 16, 1950), the Court of Appeals for the Seventh Circuit said (p. 727):

> "Plaintiff stresses that in its opinion the trial court quoted from *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 62 S. Ct. 37, 86 L. Ed. 58, and included the portion containing the unfortunate 'flash of genius' phrase. This court *has twice specifically rejected* the flash of genius test."

It is petitioner's contention that had the Court of Appeals in this case scrutinized the claims in issue in the light of the standard of invention required by this Court as formulated in its several decisions, particularly the *Cuno* case and *The Great Atlantic & Pacific Tea Company* case, it would have held the patent in suit invalid as belonging to that class of patents not sanctioned by this Court.

VIII.

The Record in This Case Clearly Shows That the Commercial Success Alleged by Respondents in Their Brief, Was the Result of Respondents' Manufacture and Sale of a Child's Set Including, in Addition to the Simulated Pig of the Patented Structure, an Unpatented Bowl With Which the Pig is Associated, and a Set Including an Ensemble of the Simulated Pig of the Patent, an Unpatented Bowl, an Unpatented Spoon and Fork, and an Unpatented Rack for the Spoon and Fork.

In respondents' advertisement (Plf. Exh. 5, R. 67) it is emphasized that "He [Hungry Piggy] is accompanied by a companion 'Piggy Bowl' comprising a two piece set with the further addition of a novel spoon, fork and stand in a five piece ensemble." See to the same effect the respondents' advertisement, Plf. Exh. 7, 9 and 11 (R. 69, 70 and 74), in which it is additionally emphasized that "The bottom of the accompanying bowl contains an engraving of a well fed little piggy and the words 'All Gone'." The evidence also shows (R. 72, Plf. Exh. 9) that to induce the sale of plaintiffs' commercial ensemble, there were offered therewith "6 cans of your favorite brand of baby food."

Upon the record in this case it is clear that separate and apart from the other unpatented items of the ensemble, the patented device has no commercial value. It is admitted by respondents (R. 19-20) that while the patented device was offered for sale separate and apart from the unpatented bowl, *it was never sold separately therefrom.*

In any event, in *The Great Atlantic & Pacific Tea Company* case, this Court succinctly stated that commercial success without invention will not make out patentability.

IX.

The standard of patentability is a Constitutional standard and the question of validity of a patent is a question of law. *The Great Atlantic & Pacific Tea Company* v. *Supermarket Equipment Corporation*, 340 U. S. 147.

Respondents urge (p. 46) upon this Court the provisions of Rule 52(a) of the Federal Rules of Civil Procedure.

Petitioner submits that a complete reply to that section of respondents' brief is found in the decision of this Court in *The Great Atlantic & Pacific Tea Company* case, wherein this Court said:

> "It is urged, however, that concurrence of two courts below, in holding the patent claims valid, concludes this Court. A recent restatement of the 'two court rule' reads, 'A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing or error.' *Graver Tank Co.* v. *Linde Co.*, 336 U. S. 271, 275. The questions of general importance considered here are not contingent upon resolving conflicting testimony, for the facts are little in dispute. We set aside no finding of fact as to invention, for none has been made except as to the extension of the counter, which cannot stand as a matter of law. The defect that we find in this judgment is that a standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components. It is on this ground that the judgment below is reversed."

In the concurring opinion in *The Great Atlantic & Pacific Tea Company* case, it was said:

> "The standard of patentability is a constitutional standard; and the question of validity of a patent is a question of law. *Mahn* v. *Harwood*, 112 U. S. 354, 358.

> The Court fashioned in *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275, a rule for patent cases to the effect that this Court will not disturb a finding of invention made by two lower courts, in absence of a very obvious and exceptional showing of error. *That rule*, imported from other fields, *never had a place in patent law.* Having served its purpose in *Graver Mfg. Co.* v. *Linde Co., it is now in substance rejected.* The Court now recognizes what has long been apparent in our cases: that it is the 'standard of invention' that controls. That is present in every case where the validity of a patent is in issue. It is that question which the Court must decide. *No 'finding of fact' can be a substitute for it in any case.* The question of invention goes back to the Constitutional standard in every case. We speak with final authority on that Constitutional issue as we do on many others."

The defect in the judgment in this case, like that in *The Great Atlantic & Pacific Tea Company* case, "is that a standard of invention appears to have been used that is less exacting than that required where a combination is made up entirely of old components." On this grounds the judgment below should be reversed as to the validity of the patent in suit.

Conclusion.

To sustain the validity of a patent of the character of that here in suit is to obstruct rather than to stimulate invention, for it tends to create, as said by this Court in *Atlantic Works* v. *Brady*, 107 U. S. 192 at 200, "a class of speculative schemers who make it their business to watch the advancing wave of improvement and gather its foam in the form of patented monopolies which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the art."

The judgment of the Court of Appeals in this case should be reversed as to the validity of the patent in suit.

Respectfully submitted,

CREST SPECIALTY (NOT INC.),
Petitioner,
By CLARENCE E. THREEDY,
Its Attorney.

Chicago, Illinois,

April 5, 1951.

FILED
MAY 7 1951
CHARLES ELMORE CROPL
CLE

IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 446

CREST SPECIALTY (NOT INC.), A LIMITED PARTNERSHIP CONSISTING OF BEN B. MANASTER, ROSE MANASTER, CAROL RUTH MANASTER, AND SOL ELIOT,

Petitioner,

vs.

DAVID C. TRAGER, DOING BUSINESS AS TOPIC TOYS, AND EOINA NUDELMAN, AN INDIVIDUAL,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

PETITION FOR REHEARING.

SIDNEY NEUMAN,
MAX R. KRAUS,
Attorneys for Respondents.